



United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PTO/SB/33 (07-05)

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>	Docket Number (Optional) 58268.09065
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed Name _____	Application Number:  09/528,000
	Filed: March 17, 2000
	First Named Inventor:  Shiri KADAMBI et al.
	Art Unit: 2616  Examiner: HOANG, Thai D.

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.


The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under  
37 CFR 3.73(b) is enclosed
- ☒ Attorney or agent of record.  
Registration No. 45,689

- ☐ Attorney or agent acting under 37 CFR 1.34.  
Reg. No. is acting under 37 CFR 1.34 \_\_\_\_\_

  
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05/19/2006  
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Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

- ☐ \*Total of \_\_\_\_\_ forms are submitted.



**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Shiri KADAMBIL et al.

Art Unit: 2616

Application No.: 09/528,000

Examiner: HOANG, Thai D.

Filed: March 17, 2000

Attorney Dkt. No.: 58268.09065

For: METHOD FOR MANAGING CONGESTION IN A NETWORK SWITCH

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

May 19, 2006

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejection of claims 1, 2, and 5 in the above identified application. Claims 1, 2, and 5 were finally rejected in the Office Action dated February 21, 2006, Applicants filed a Response to the Final Office Action on March 16, 2006, and the Office issued an Advisory Action dated April 17, 2006, maintaining the final rejection of claims 1, 2, and 5. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Applicants respectfully submit that a *prima facie* case supporting the rejection of claims 1, 2, and 5 under 35 U.S.C. §102(e) has not been established, that there is clear error in the rejections of claims 1, 2, and 5, and that there is clear error in the application of knowledge of one of ordinary skill in the art in support of the §102 rejection.

More particularly, in the Final Office Action dated February 21, 2006, claims 1, 2, and 7 were finally rejected under 35 U.S.C. 102(e) as being unpatentable over *Schwartz* (U.S. Patent No. 6,434,115). The Office Action took the position that *Schwartz* taught each and every limitation recited in claims 1, 2, and 5. This rejection is appealed.

Claim 1, the independent claim upon which claims 2 and 5 depend, recites a method for managing congestion in a network switch, wherein the method expressly includes the steps of determining if a destination port is a monitored port and prescheduling transmission of an incoming packet to the destination port if the destination port is determined to be a monitored port. The method further includes the step of stripping a module header from packets received via a high performance interconnect link of the network switch.

Applicants submit that *Schwartz* fails to teach or disclose each and every element recited in claim 1. More particularly, although *Schwartz* teaches monitoring the output ports to determine if the associated buffers are full at column 11 to column 13 (as cited by the Office Action), *Schwartz* does not teach or disclose making a determination as to whether a particular port is monitored or not. Applicants submit that the fact that *Schwartz* teaches monitored ports does not support the Office Action's conclusion that

*Schwartz* teaches determining if a port is monitored. Applicants submit that there is no teaching or disclosure in *Schwartz* of making any sort of determination that a port is monitored, and as such, there is also not any teaching or disclosure in *Schwartz* of prescheduling transmission of an incoming packet to the destination port if the destination port is determined to be a monitored port, as recited in claim 1. Thus, two elements expressly recited in Applicants claim 1 are determining if a port is monitored and prescheduling packets if the port is monitored, and neither of these elements are taught or disclosed by *Schwartz*. Therefore, Applicants submit that there is clear error in the application of the prior art to the present claims, and reconsideration and withdrawal of the rejection is respectfully requested.

Further, Applicants submit that *Schwartz* also fails to teach or disclose stripping a module header from packets received via a high performance interconnect link, as expressly recited in claim 1. The Final Office Action cited to column 23, lines 60-61 as teaching this feature, however, careful review of this section does not support this conclusion. The cited section deals with the high traffic capacity of the switch, and not with any sort of header stripping operation. Applicants traversed this particular point in the Response to Final Office Action, and the Advisory Action responded by taking a different position, *i.e.*, that “although *Schwartz* does not explicitly describe this step (the stripping), this is general knowledge of one of ordinary skill in the art.” This conclusion was not supported in the Advisory Action by a citation to any reference, printed publication, or by any sort of taking of Official or Judicial Notice, as required to properly

support a §102 rejection. Therefore, Applicants submit that clear error is present, as the rejection has not met the statutory criteria required to properly support a *prima facie* §102 rejection. Reconsideration and withdrawal of the rejection is respectfully requested.

Further, Applicants acknowledge that anticipation under §102 may exist even though the prior art reference does not identically disclose each aspect of the claimed invention in situations where the missing subject matter is inherent in the teaching of the reference. However, in these “very limited circumstances,” the Office Action should fill the gap between the teaching of the reference and the recited claim limitation asserted to be inherent with documentation/extrinsic evidence that makes clear that the missing element is “necessarily present” in the described reference, as the mere fact that the missing element “may be included in the cited reference is not sufficient” to establish inherency. (*See, In re Oelrich*, 212 USPQ 323, 326, (CCPA 1981) and *Continental Can Co v. Monsanto*, 20 USPQ 2d at 1749050.) In the present case, Applicants submit that clear error would exist in an inherency assertion, as the Office Action has not provided the requisite documentation or citation supporting the conclusion the missing element (the stripping function) is “necessarily present” in *Schwartz*. As such, reconsideration and withdrawal of the rejection of claims 1, 2, and 5 is respectfully requested.

In conclusion, Applicants submit that clear error exists in the application of *Schwartz*, as the reference fails to teach or disclose the recited steps of determining a monitored port and stripping a header from a packet received from a high performance

interconnect link. In view of the clear error, Applicants submit that the §102 rejection is not proper, and reconsideration and withdrawal of the rejection is respectfully requested.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'N. Alexander Nolte', is written over a horizontal line.

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